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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,644	08/13/2001	Noriyuki Matsui	1341.1103	7992

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EXAMINER

HIRL, JOSEPH P

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/927,644

Examiner

Joseph P. Hirl

Applicant(s)

MATSUI ET AL.

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

Peri d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered November 24, 2003 for the patent application 09/927,644 filed on August 13, 2001.
2. The First Office Action of August 4, 2003 is fully incorporated into this Final Office Action by reference.
3. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.
4. Examiner's Opinion:

Para 2 above applies. The changing of the claims such that a user is now controlling the process specifically violates the concept of concreteness under 35 USC 101 and makes this entire application non statutory. Applicants arguments are in fact moot since the claim changes are non statutory.

Status of Claims

5. Claims 1-8 are amended. Claims 9-12 are new. Claims 1-12 are pending.

Response to Arguments

6. The rejection of claims 5-8 under 35 USC 101 is withdrawn related to the issue of intangibility.

7. Applicant's arguments filed on November 24, 2003 related to Claims 1-8 have been fully considered but are not persuasive.

In reference to Applicant's argument:

The Hennessey reference relates to generating and managing a knowledge database used in identifying anomalies in an object using image processing. In Hennessey, an image of the product having an anomaly is captured, and the image is converted into a pixel-based digital image. The digital image is then decomposed into a basic-element-based or primitives-based representation of the image, and the anomaly is isolated on the decomposed image. The anomaly is compared with stored decomposed images of known anomalies in the knowledge database to find a stored decomposed image having a maximum similarity. A label associated with the stored decomposed image having the maximum similarity is presented to an operator, and the operator then enters the label into the knowledge database to be associated with the decomposed image (Hennessey at col. 2, lines 9-14).

The Examiner has asserted that the "questions" of the present invention read on the "anomalies" or "defects" of Hennessey. Thus, the Examiner has implied that the "causes" of the present invention are associated with the "defects" of Hennessey and read on the "labels" (names or classifications identifying the "defects") of Hennessey. However, Hennessey merely discloses comparing data stored in the knowledge database with the captured image data, and using an algorithm to extract data that are most similar to the captured image data from the knowledge database. Thus, Hennessey does, not disclose "displaying the certain questions to the user; receiving answers from the user corresponding respectively to the certain questions; and extracting causes with high correlation levels from the plurality of causes based on the answers from the user," as recited in claim 1.

Examiner's response:

Para 2 above applies. Please see 35 USC 101 rejection below regarding user answers and the violation of the principal of concreteness. Hennessey focuses on

labeling anomalies on a manufacturing object which is analogous to cause and effect or the association of questions with effects with strong correlation (Hennessey, c 2, l 9-23). Defects are selected by the user through the user interface (Hennessey, c 37, l 40-42).

In reference to Applicant's argument:

For example, claim 4 recites "assigning a weight to each of the answers." As discussed above, Hennessey does not disclose obtaining "answers" from the user. Thus, Hennessey does not disclose "assigning a weight to each of the answers," as recited in claim 4. Therefore, for at least this reason and the reasons set forth above with respect to claims 1 and 5, it is submitted that dependent claims 2-4 and 6-8 patentably distinguish over the prior art.

Examiner's response:

Above discussions apply. Applicant's arguments are moot since the claim changes have reduced the application to a strong non-statutory level.

In reference to Applicant's argument:

Independent claim 9 recites " ... a first control unit extracting certain questions from the plurality of questions using an algorithm based on the correlation levels, displaying the certain questions to be answered by a user on the display, and receiving answers from the user via the network, the answers corresponding respectively to the certain questions and being input by the user using the input device; and a second control unit extracting causes with high correlation levels from the plurality of causes based on the answers from the user." These features are not taught or suggested by the cited reference.

Examiner's response:

Above discussions apply. Applicant's arguments are moot since the claim changes have reduced the application to a strong non-statutory level.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The practical application test requires that a useful, concrete and tangible result be accomplished. Claims 1-12 specifically require user inputs which creates uncertainty since one user input will differ from another user input. Consequently, the principal of concreteness has been violated and the claims 1-12 are non statutory. Simply stated, a patent cannot be developed around a "user" (person) response...this violates the principal of concreteness.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 USC 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This is how the MPEP puts it:

("The how to use prong of section 112 **incorporates as a matter of law** the requirement of 35U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. 101, then the application **als fails as a matter f law** to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, '376 F.2d 936, 942, 153 USIPQ 48, 53 (CCPA 1967) ("Necessarily,

compliance with § 112 requires a description of how to use presently useful inventions, **therwis an applicant w uld anomalously be requir d t t ach how t us a us l ss invention."** See, MPEP 21107.01 (IV), quoting In re Kirk (emphasis added).

Therefore, claims 1-12 are rejected on this basis.

Claim Rejections - 35 USC § 102

10. Since the claims are non statutory, the claims cannot be reviewed for prior art since one would have to conduct a non-statutory review. For guidance, the references used in the prior office action should be used.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Claims 1-12 are rejected.

Correspondence Information

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anil Khatri can be reached at (703) 305-0282.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Application/Control Number: 09/927,644

Page 8

Art Unit: 2121

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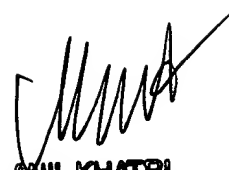
Receptionist, Crystal Park II

2121 Crystal Drive,

Arlington, Virginia.

Joseph P. Hirl

February 11, 2004



ANIL KHATRI
SUPERVISORY PATENT EXAMINER